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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,605	05/25/2006	Hisayoshi Ito	2224-0259PUSI	4963

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EXAMINER

HEINCER, LIAM J

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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01/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/580,605	ITO, HISAYOSHI	
	Examiner	Art Unit	
	Liam J. Heincer	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Election/Restrictions

Applicant's election with traverse of group II in the reply filed on November, 19, 2007 is acknowledged. The traversal is on the ground(s) that Tomka et al. does not teach the composition of claim 1. This is not found persuasive because claim 1 is still shown in the prior art. Yatake (US 2003/0078230) teaches composition comprising a coloring agent (¶0112) and an organic polymer component (¶0114); and a matrix comprising at least an oligosaccharide (¶0190).

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 3-15, and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 19, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 19, 21-23, 25,26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takenishi et al. (EP 555,980) in view of Mychajlowskij et al. (US Pat. 5,945,245).

Considering Claims 16, 19, and 22: Takenishi et al. teaches a process for producing a particle comprising washing/eluting a water soluble auxiliary (3:16-17) from a composition comprising an oligosaccharide (2:51-53) and an organic polymer (2:45-47).

Takenishi et al. does not teach adding a colorant to the composition. However, Mychajlowskij et al. teaches adding a dye or pigment to a particle forming composition

(12:19-20) in a weight percentage of 1 to 65% (12:14-18). Takenishi et al. and Mychajlowskij et al. are combinable as they are concerned with the same field of endeavor, namely polymer particle formation. It would have been obvious to a person having ordinary skill in the art at the time of invention to have added a colorant to the composition of Takenishi et al. as in Mychajlowskij et al., and the motivation to do so would have been, as Mychajlowskij et al. suggests, it will make a colored particle (12:23-27).

Considering Claim 21: Takenishi et al. teaches the polymer size as being below between 0.1 and 30 μm (3:7).

The Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients and process steps. Therefore, the claimed effects and physical properties, i.e. the shape, the coefficient of variation of the average particle size and the length ratio of the major to the minor axis would implicitly be achieved by a process using the claimed ingredients and process steps. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Considering Claim 23: Takenishi et al. teaches the oligosaccharide as being a trisaccharide (2:54-55). A tetrasaccharide is a homologue of a trisaccharide. A person having ordinary skill in the art at the time of invention would have expected the two compounds to have had similar properties and would have found it obvious to use one in place of the other.

Considering Claim 25: Takenishi et al. does not teach the oligosaccharide as having the claimed viscosity. However, it is well known in the art to optimize result effective variables such as viscosity. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used an oligosaccharide with the claimed viscosity in the process of Takenishi et al., and the motivation to do so would have been to control the processability of the mixtures. See MPEP §2144.05.

Considering Claims 26, 28, and 29: Takenishi et al. teaches the composition as additionally comprising erythritol (2:51-53).

Considering Claim 30: Takenishi et al. does not teach the claimed weight ratio.

However, it is well known in the art to optimize result effective variables such as weight ratios. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the claimed weight ratio in the process of Takenishi et al., and the motivation to do so would have been to optimize the viscosity of the composition, thereby optimizing the processability of the composition. See MPEP § 2144.05.

Considering Claim 31: Takenishi et al. teaches using the auxiliary component in a ratio of 40/50 to 60/50 with respect to the polymer (2:56-57).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takenishi et al. (EP 555,980) in view of Mychajlowskij et al. (US Pat. 5,945,245) as applied to claim 16 above, and further in view of Bähler (US Pat. 6,800,127).

Considering Claim 20: Takenishi et al. and Mychajlowskij et al. collectively teach the process of claim 16 as shown above. Takenishi et al. also teaches the polymer size as being below between 0.1 and 30 μm (3:7).

Takenishi et al. does not teach the particle size of the pigment as being as claimed. However, Bähler teaches the pigment size as being below 0.2 μm /less than 50% of the polymer particle size (abstract). Takenishi et al. and Bähler are combinable as they are concerned with the same field of endeavor, namely polymer particle dispersions. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the pigment size of Bähler in the composition of Takenishi et al., and the motivation to do so would have been, as Bähler suggests, to provide a uniform blend of pigment and polymer particles (1:43-54).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takenishi et al. (EP 555,980) in view of Mychajlowskij et al. (US Pat. 5,945,245) as applied to claim 16 above, and further in view of Nambu et al. (US Pat. 5,596,056).

Considering Claim 24: Takenishi et al. and Mychajlowskij et al. collectively teach the process of claim 16 as shown above.

Takenishi et al. does not teach the oligosaccharide as being from the claimed group. However, Nambu et al. teaches using glactooligosaccharide or fructooligosaccharide as an auxiliary agent to control polymer particle shape (4:13-23).. Takenishi et al. and Nambu et al. are combinable as they are concerned with a similar technical difficulty, namely controlling the shape of polymer particles. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the oligosaccharides of Nambu et al. in the process of Takenishi et al. and the motivation to do so would have been, as Nambu et al. suggests, the oligosaccharides are functionally equivalent to the sucrose or cellobiose of Takenishi et al. (4:13-23).

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takenishi et al. (EP 555,980) in view of Mychajlowskij et al. as applied to claim 26 above, and further in view of Tomita et al. (US 2001/0026898).

Considering Claim 27: Takenishi et al. and Mychajlowskij et al. collectively teach the process of claim 26 as shown above. Takenishi et al. also teaches the same plasticizer as in the specification. Therefore the component should have the desired melting point.

Takenishi et al. does not teach a polymer component with the heat distortion temperature being below that of the oligosaccharide. However, Tomita et al. teaches using a low melting polymer in the production of polymer particles (§10007). Takenishi et al. and Tomita et al. are combinable as they are concerned with the same field of endeavor, namely polymer particle production. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used a low melting resin in the production of the polymers of Takenishi et al. as in Tomita et al., and the motivation to do so would have been, as Tomita et al. suggests, to they reduce the energy needed during polymerization (§10007)..

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892.

Response to Arguments

Applicant's arguments with respect to claim 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

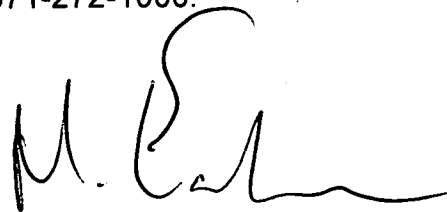
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LJH

December 31, 2007



MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

07/Jun/08